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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,941	06/25/2001	Theresa A. Burkes	10008291-1	9288
7590 02/26/2007 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER BROOKS, MATTHEW L	
			ART UNIT	PAPER NUMBER
			3629	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/888,941	<b>Applicant(s)</b> BURKES ET AL.	
	<b>Examiner</b> Matthew L. Brooks	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15 and 17-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15, 17-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Interviews Summaries**

1. Applicant's Agent and Examiner have spoken on several occasions and Applicant has been made aware on all of these occasions that the independent claims could be made allowable by inserting/including language as seen in dependent claims 27 and 30. Examiner is still under the hard studied impression that the true novelty of the invention is that of starting a warranty after a specified quantity of output for a peripheral/printer. Applicant has been made aware on all occasions that starting the warranty after the first output or first print is equivalent to starting a warranty after the first use of a product a concept which is old and well known in the art of warranty start dates for a product. Applicant was also notified that if language were inserted to make the warranty start event a production of output greater than one a patent would lie.

NOTE: Examiner has used for example on the rejections made below representative invention independent claim 1 and dependent claims 2-6, 8-12, and 27-34; because no election/restriction was made the same analysis applies to the other independent claims and its dependents.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-6,8-15 and 17-34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to claim 1 for instance, Examiner in previous action stated that Applicant was missing essential step between limitations (a) and (b) that of the "occurrence of the event". Applicant has recited on page 10 bridging page 11 that there has been no positive recitation of such a step. Examiner agrees completely. There needs to be a positive recitation of the production of the output/printed documents in order for the generation of the timestamp to occur and hence for the invention to work. It is suggested that the Applicant have the independent claim/s read in some similar manner as presented directly below.

(a) defining a warranty start event for a product comprising production of specified quantity of output greater than one,

(b) product produces a specified quantity of output greater than one

(c) generating a timestamp for the product after detection of the occurrence of said warranty start event; and

(d) storing said timestamp in memory.

This would in effect be a satisfactory positive recitation claiming the invention. The section that applicant cited in his remarks about the Applicant can be his/her own lexicographer is not relevant because the 112 rejection is not being made for this reason, but rather to require the positive recitation of the invention so persons may know the scope of the invention.

5. With respect to Claim 32 Examiner cannot even examine this claim as it makes little sense and is an omnibus type claim.
6. Claim 33 fails to limit see claim 1 (b).
7. Claim 33 is a dependent claim that is attempting to broaden. This is not allowed further the claim likely would comprise a new invention and may be subject to restriction upon return.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims **1-3, 5-6, 8-9, and 12, 15, 17-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No.: 6,519,470 (Rydbeck).
10. With respect to the Method claims 1-6 and 8-12 for example; Claim 1 Rydbeck teaches a method for determining when a warranty for a product/peripheral/wireless

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communications device begins, equivalent to “warranty start date” further Rydbeck teaches:

- (a) defining a warranty start event for a product (Column 2, 40-43 “first use”);
- (b) generating a timestamp for the product after detection of the occurrence of said warranty start event (C7, 59-68 “date stamp occurs at first use date”);
- (c) storing said time stamp in memory (C2, 30-35)
- (d) wherein the product is for producing output, and wherein said warranty start event comprises production of a specified quantity of the output (in the terms of a product such as a peripheral/input-output device like a phone the first use is considered output and the first use thereof is a species that falls with in the range of a specified quantity of output if the specified quantity of output is equal to one/first use.)

11. With respect to **Claim 2**: Rydbeck discloses

reading said time stamp from memory to determine the warranty start date (C7, 59-63 “looking at the start date”).

12. With respect to **Claim 3**: Rydbeck discloses

wherein said memory is internal to the product (C2, 1-3).

13. With respect to **Claim 5 and 6**: Rydbeck discloses

Obtaining timestamp over a network (C5, 20-37). And the memory where timestamp is stored is remotely located from the product (C5, 20-37).

14. With respect to **Claim 8**: Rydbeck discloses

A product for connection to a network and obtaining a timestamp over the network (C5, 20-37 and C7, 59-69).

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15. With respect to **Claim 9**: Rydbeck discloses  
Obtaining time stamp over network in appropriate protocol. (C5, 25-35).
16. With respect to **Claim 12**: Rydbeck discloses\  
Continuously searching for occurrence of warranty event (C7, 59-68 and  
C8, 1-5).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims **4, 10-11 13-14, and 15-26 and 28-29 and 31-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: 6,519,470 (Rydbeck).
4. With respect to the Method claims 1-6 and 8-12 for example; Claim 1 Rydbeck teaches a method for determining when a warranty for a product/peripheral/wireless

communications device begins, equivalent to "warranty start date" further Rydbeck teaches:

- (a) defining a warranty start event (Column 2, 40-43 "first use");
- (b) generating a timestamp with the product after detection of the occurrence of said warranty start event (C7, 59-68 "date stamp occurs at first use date);
- (c) storing said time stamp in memory (C2, 30-35)
- (d) wherein the product is for producing output, and wherein said warranty start event comprises production of a specified quantity of the output (in the terms of a product such as a peripheral/input-output device like a phone the first use is considered output and the first use thereof is a species that falls within the range of a specified quantity of output if the specified quantity of output is equal to one/first use.)

Rydbeck shows all of limitations as laid out above and above in 102.

Rydbeck fails to show obtaining the time stamp from an internal clock, encrypting time stamp while storing, outputting an encrypted timestamp and that the "output" is printed documents.

The examiner takes Official Notice that obtaining a time for timestamp purposes and encryption of said stamp is old and well established in the business of timestamping as a convenient way for a business to obtain from a product an appropriate first use date. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of encrypting timestamp in Rydbeck by encryption techniques because the skilled artisan would have recognized that this business practice protects the data from being read, altered and corrupted and is clearly



applicable to the time stamping of any type of product. These advantages are well known to those skilled in the art.

With respect to the "output" not being printed documents. With respect to the Application at hand it is abundantly clear that the Applicant has envisioned two embodiments when Examiner turns to the Applicant's Abstract lines 8 and 9; "warranty start events comprise first use by the user, and production of a specified cumulative quantity of product output. Examiner is of position that the first use of a product, is known with in the art as the start date of a warranty and time stamping thereof if use has occurred in external/internal memory is obvious to one of ordinary skill (as shown by Rydbeck).

It is the later, "warranty start event" that is novel and patentably distinct in the art; that of starting the warranty upon the production of a specified cumulative quantity of output. The problem lies in that if the specified quantity of output is only one, that is the equivalent of a first use.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Rydbeck, which teaches starting the warranty event after a first use, to other products and/or peripherals, if their first use was the production of a document or specified output greater than zero because the teaching of the telephone device in Rydbeck is a peripheral and or input/output device and the advantages of starting the warranty after the first use of such a device were well known in the art.

***Response to Arguments***

17. In response to page 10 bridging 11, Applicant should see 112 made above, the issue is not about being ones own lexicographer but rather that the claims must positively recite all limitations.

18. In response to bottom of page 11, Applicant asserts that the reference Rydbek fails to teach "production of a specified quantity of output". Applicant is wrong in that given the broadest reasonable interpretation of the claims a cell phone is known in the art as being both a peripheral and an Input/Output device. The moment it is turned on and connected to the cellular station it is producing output by definition. To preempt arguments made that it is not outputting documents, Examiner made the decision upon original presentation of the claims not to make a restriction/election. This was due to the fact that the Applicant wanted the invention to encompass all peripherals, this is obviously meant to include printers. It just so happens that their output is a printed document. IF Applicant thought there was a patentably distinct difference between the peripherals of a telephone and a printer Applicant should argue on record accordingly. The same analysis applies to Remarks bridging 12 and 13; that if Applicant thinks having the timestamp internally or externally is not an obvious or arbitrary design choice then it should be noted on record as such. However Examiner has considered this difference an obvious choice of design to which applicant has claimed both combinations in separate dependant claims and Examiner found one.

19. In response to Applicant's Remarks from middle of page 14 bridging page 15 that there is no teaching of obtaining a timestamp over a network, given the broadest

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reasonable interpretation of the claim Examiner respectfully disagrees. (see rejection above for support.

20. In response to middle of page 14 in regards to Examiners taking of official notice that encryption of timestamps was well known with in the art. Official Notice is proper when the facts are capable of instant and unquestionable demonstration as to defy dispute. In this case Examiner clicked on EAST typed in "time adj stamp" and hit enter then typed in the word above in the same sentence as encrypt. The whole process took about ten seconds and the following support was immediately provided.

5737415

ETX (110):

The control center 31 issues authorization commands to the data reproducing device 105, **encrypts** utilization starting time (**time stamp**) corresponding to software, and sends it to the data reproducing device 105 through communication lines (or via modem).

5737419

52):

The first user's computer is then driven by the programming stored thereon to obtain the first symmetric session crypto-key by applying the temporary private key portion, which only should only be available to the first user's computer, to decrypt the fourth encrypted message. The first user's computer is also operated to further encrypt the third encrypted message with the temporary private key portion to form a fifth encrypted message. Additionally, the first user's computer **encrypts** a second message, such as a **time stamp**, with the first symmetric session key to form a sixth encrypted message.

Brief Summary Text - BSTX (59):

In accordance with yet other aspects of the invention, joint signatures can be performed by two users, for instance the first and second users described above, using the temporary crypto-key. The first user's computer is driven by the programming stored thereon to generate a hash message and a time stamp encrypted with the first private key portion of the first user's

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crypto-key to form an encrypted message. A signature of the first user is thereby placed on the hash message. The first user's computer is also driven to **encrypt** the encrypted hash and **time stamp** message with the temporary private key portion and with the first private key portion of the first user crypto-key to form a further encrypted message. The first user's computer is further driven by the stored programming to encrypt the temporary public key portion with the first private key portion of the first user crypto-key to form another encrypted message.

5924094

The security of the IDDBMS preferably depends only on the actual cryptographic keys used to create certificates or secure each site, and the mechanisms used to manage and protect those keys so that they are never divulged to an attacker, including protocols and key management. This approach is based on the assumption that an attacker will have full knowledge about how the IDDBMS stores keys, **encrypts time-stamps**, calculated uniqueHashes and fragHashes, and so on.

6046696

158):

The client **encrypts** certification results using XOR-encryption, based on a separately encrypted date and **time stamp**, performs positional manipulation of the resulting encrypted data to provide further protection. This results in an encryption scheme that changes for every single data set and is very difficult to defeat, while being simple to implement in software.

5150407

A device for storing user data and a value representative of the time of storage is disclosed, which includes physically separating portions of an encryption key, combining a **time stamp** with user data, and using the restored encryption key to **encrypt** and decrypt the stamped user data.

Thus Examiner is certain the Official Notice taken of the facts that encryption of a time stamp was known with in the art will stand.

21. In response to pg 17 referring to independent claim 15 that Rydbeck fails to teach "retrieval of by the product of the stored warranty event definition from a memory" then states to the contrary Rydbeck merely discloses the turning of the phone on starts the warranty registration process. This in and of itself is sufficient to meet the claims, certainly it is inherent that a memory residing on the phone has stored in it that turning on the phone starts the registration process and it just so happens that the turning on of the phone is a production of output thus given the broadest reasonable interpretation of the claim its scope is satisfactorily met.

***Allowable Subject Matter***

Claims 30 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB  
2/19/07



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